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Client No.: BillPay-G

PATENT



#22 Walden 4.1.04

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Art Unit: 3625
KIGHT, et al. :

Serial No: 09/542,109 : Examiner: Y. Garg

Filed: March 31, 2000 :

For: BILL PAYMENT SYSTEM AND METHOD UTILIZING BANK ROUTING NUMBERS

**REPLY BRIEF**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 20, 2003

Sir:

This Reply Brief is submitted in response to the Examiner's Answer issued on November 19, 2003, the time for response to which is up to and including January 19, 2004.

## REMARKS

The Examiner reiterates the basis for rejection set forth in the final Official Action in Section 10, on pages 4-7 of the Examiner's Answer.

The Examiner responds to arguments presented in the Appeal Brief in Section 11, on pages 7-21 of the Examiner's Answer.

Beginning on page 7, the Examiner addresses arguments presented on pages 13-15 of the Appeal Brief. As discussed on pages 13-15 of the Appeal Brief, Braun explicitly discloses that the routing number (which is included in the MICR encoded account number entered by the customer at the ATM) is always checked at the customer's financial institution against stored information representing routing numbers for accounts of only that financial institution, in order to verify the received routing number. Referring to Figure 3 of Braun, it should be noted that if the data processor 19 is the data processor of the customer's financial institution (e.g., the customer is using its own bank's ATM), there is no need for a transmission to the data processor 23. However, if the data processor 19 is not the data processor of the customer's financial institution (e.g., the customer is using another banks ATM), the MICR encoded account number (which includes the routing number) is transmitted via the data link 20 and central switching and processing center 22 to the data processor of the customer's financial institution 23. This is made clear, for example, by the disclosure in column 9, lines 47-62, and column 10, lines 60-67.

Hence, in Braun, the customer's financial institute which receives the routing number has no need to compare the routing number against a stored plurality of routing numbers associated with a plurality of financial institutions in a financial institutions files

to verify accuracy of the received routing number, since this would only require unnecessary storage and processing. Rather, all that is required in Braun is that each financial institution compare a received routing number to the routing number(s) associated with that financial institution to verify the accuracy of the received routing number, since it is only required to verify routing numbers for its own customers (and therefore, only its own routing numbers).

However, the Examiner asserts on page 7, that "This argument has no relevance to the recited limitations in claim 36". The Examiner further asserts that "Braun discloses these limitations" on the basis that "the customer can have multiple accounts, and those accounts can belong to one or more financial institutions (see at least, column 12, lines 58-66)".

The referenced text in column 12 does not in anyway suggest that the multiple accounts being discussed are multiple accounts at different financial institutions. Rather, when Braun is read as a whole, including not only the disclosure in columns 9 and 10 referenced above, but also in column 11, line 61, through column 12, line 8, and column 12, lines 58-66, it is clear that the multiple accounts being referred to are multiple accounts maintained at a single customer financial institution.

The Examiner asserts that "It would be obvious to one of ordinary skill in banking and check processing field, that when a customer has multiple checking accounts, they could be with different banks/financial institutions and different routing numbers and as such, when verifying the routing numbers, all those routing numbers would be stored in the system. Further, there will be more than one customer who will be using ATMs and ATSs, and different customers could have checking account numbers with different

financial institutions having different routing numbers. This inherently means that a plurality of routing numbers are stored, and while verifying the routing numbers, they are compared with the plurality of stored routing numbers.

It is respectfully submitted that it is only the present disclosure which would make these features obvious. Contrary to the Examiner's assertion, although a customer may have multiple checking accounts with different financial institutions having different routing numbers, according to Braun, the routing number for each of these financial institutions, would be verified only by that financial institution, and that financial institution would have no need to compare a received routing number to a financial institutions file having a plurality of routing numbers associated with a plurality of financial institutions. Furthermore, although there will be many customers using ATMs with different accounts at different financial institutions having different routing numbers, here again according to Braun, the verification of the routing number is done by each respective customer's financial institution, and not by other financial institutions. The referenced text in column 3 does not in anyway contradict what has been explicitly disclosed elsewhere by Braun. Indeed, the reference text in column 20 supports Applicants' position that the routing number is verified at the customer's financial institution (e.g., in this position of the disclosure represented by processor 23), and that the multiple accounts are multiple accounts at the same customer financial institution (e.g., a savings account and a checking account). Here again, the referenced text in column 20 does not in anyway contradict the explicit disclosure of Braun regarding where the verification of routing numbers occurs (i.e., that routing numbers of a customer's financial institution are only verified by that financial institution).

On page 9, in the first full paragraph, the Examiner takes exception to the assertion, on page 14 of the Appeal Brief, that the Examiner acknowledged Braun's failure to disclose the required comparing of a received routing number to the plurality of routing numbers stored in such a file to verify accuracy of the received routing number. However, the Examiner goes on to state that it is acknowledged that Braun "does not disclose that the stored plurality routing numbers of financial institutions are stored together in a designated financial institutions file".

Logically, if Braun lacks the recited financial institutions file, Braun necessarily lacks a comparison of a received routing number to routing numbers stored within such a file.

In the paragraph bridging pages 9 and 10 of the Examiner's Answer, the Examiner asserts that "Braun does store a plurality of routing numbers". However, what the Examiner continues to ignore is that the claims require that the stored plurality of routing numbers be associated with a plurality of financial institutions, and this is clearly lacking in Braun. Furthermore, Braun has no need for Paschal's file since each financial institution need only verify its own routing numbers and not the routing numbers of other financial institutions according to Braun.

Thus, even if the proposed combination were motivated (which is respectfully submitted is not the case), it would still lack any suggestion of the recited combination of limitations.

The Examiner cites and refines, however, what the Examiner has failed to do is to show objective teaching in the prior art or prior knowledge available to those of ordinary skill in the art which would have led to combine the Braun and Paschal

teachings, since Braun has no need for Paschal file. With regard to In re Bozek, In re Bode, et al. and In re Sheppard, it is respectfully submitted that these cases fail to support the Examiner's asserted conclusions, because the Examiner has failed to establish any reasonable inferences which can be drawn from the applied prior art, including anything that could reasonably be viewed as implied by the applied prior art disclosures, which would suggest the present combination of limitations, including, the comparison of a received routing number to a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file to verify the accuracy of the received routing number, since Braun has no need for such a comparison in order to perform verification at the customer's financial institution. The test is not, if individual elements of the invention can be found in the prior art, but whether the prior art suggest the claimed combination of features and limitations. Indeed, many recently issued patents rely on elements which are well known in the art, but which are combined in a new and unobvious way to solve a particular problem. The Examiner is correct that references may be relied upon for all that they reasonably suggest to one of ordinary skill in the art, whether or not the particular relied upon disclosure relates to preferred or non-preferred embodiments.

However, in the case under appeal, the Examiner has failed to produce objective evidence of a reasonable suggestion of the present invention within the applied prior art. Rather, the only disclosure within the record of this case which suggests the Examiner's proposed modifications, is the present application itself.

Although the Examiner responds to certain arguments presented in the Appeal Brief, the Examiner appears to ignore other of the arguments presented in the Appeal

Brief including those relating to the Examiner's proposed modification of Braun, violating a principle of its operation, and resulting in unnecessary storage and processing.

Furthermore, the Examiner appears to have ignored or accepted the arguments presented on pages 15-17 relating to claims 40, 42-44, 46-48, 50-56 and 58-61.

The Examiner also does not respond to the arguments presented on pages 19 and 20, relating to the lack of motivation for the proposed combination with respect to claim 36.

In addressing the arguments on pages 20-22 of the Appeal Brief relating to the motivation to further modify the base combination in view of Lawlor and Case, in support of the rejection of claim 40, the Examiner asserts that "Lawlor explicitly teaches making determination if payments can be implemented via electronic funds transfer and if not, an alternative method such as paper". However, the Examiner's statement obscures the issue as well as the relevant teachings of Lawlor. More particularly, as discussed above, Lawlor requires a specific type of electronic debiting. More particularly, Lawlor requires ATM debiting of the consumer's account. What the Examiner is referring to in the noted assertion is the crediting of the merchant or payee's account, not the debiting of the consumer's account.

Claim 40 requires determining if the consumer financial institution accepts electronic fund transfers and generating an instruction to pay the bill by electronic transfer from the consumer deposit account, if the consumer financial institution is determined to accept electronic fund transfers. Hence, claim 40 relates solely with the debiting of the consumer's account, and has nothing whatsoever to do with the crediting

of the merchant's account. Hence, contrary to the Examiner's assertion that "Both Lawlor and the Applicants suggest the same solution to the problem", the solution disclosed by Lawlor and the present application are entirely different. Indeed, Lawlor teaches against other than ATM debiting of the consumer's account, and indeed this is a principle of Lawlor's operation. Hence, contrary to the Examiner's assertion and reliance on In re Gershon, et al., Lawlor does not suggest the existence of the problem solved by the invention recited in claim 40, or in anyway suggest doing what is required by claim 40. Rather, Lawlor teaches against making such a determination since Lawlor requires in all cases that debiting of the consumer's account be performed electronically via ATM debiting. Contrary to the Examiner's contention, this is not a mere recognition of latent properties as discussed in In re Wiseman. Nor is the required determination fairly suggested by that which is explicitly or implicitly disclosed within the applied prior art. Rather, what the Examiner has proposed violates principles of operation of the applied prior art, and is contrary to their explicit teachings. The Examiner argues that "one can not show non-obviousness by attacking references individually, where the rejection is based on combinations of references", however, the attacks on Case on pages 16 and 17 is an attack on what the Examiner contends is disclosed within Case. As noted in the presented arguments within the Appeal Brief, contrary to the Examiner's contention that Case teaches a determination as to whether or not the consumer's financial institution accepts electronic fund transfers, based on a verified routing number, Case in fact teaches no such thing, and hence the Examiner's reported support for the rejection is in fact lacking.

The Examiner contends that Case in column 4, lines 61-63, "Explicitly discloses that routing numbers of financial institutions do determine if electronic funds can be implemented by the financial institutions". However, as discussed in detail in the paragraph bridging pages 16 and 17 and the first full paragraph on page 17 of the Appeal Brief, Case only teaches that the account holder punches or prepunches element 37 on a portion of a draft detailed in Figure 3A. There is nothing which the Examiner has identified within Case to suggest that a determination as to whether or not to punch element 37 (i.e., thereby selecting electronic fund transfer from the account holder's deposit account), is made based on a routing number, let alone a routing number after it has been verified.

The Examiner again selectively and confusingly quotes language from Lawlor relating to crediting of the merchant's account rather than debiting the consumer's account. However, this does not change the facts as to what is disclosed within the prior art.

The Examiner's assertion in the penultimate paragraph on page 14 is simply not understood. It appears that the Examiner first disagrees and then repeats substantially what was disagreed to.

In the paragraph bridging pages 15 and 16 of the Examiner's Answer, the Examiner notes that on pages 20-21 of the Appeal Brief it is noted that Lawlor requires that all transfers from the consumer's account be by ATM debiting, which logically means that Lawlor has no need to determine whether or not a consumer's financial institution accepts electronic fund transfers. However, in addressing this very substantial point, the Examiner's sole response is "The Examiner declines to respect

this interpretation for same reasons as analyzed above". However, this particular point has not been addressed previously in the Examiner's Answer. In the second paragraph on page 28 of the Examiner's Answer, the Examiner notes that on pages 24-25 of the Appeal Brief, it is argued that according to Braun, each financial institution only verifies its own routing numbers, and therefore a financial institution would have no need to store a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file. In reply, the Examiner states that "The Examiner does not agree for the same reasons as analyzed above". However, this very substantial point has not been analyzed previously in the Examiner's Answer. On pages 24-30, specific limitations of numerous claims which are believed to patentably distinguish over the applied prior art, along with detailed supporting arguments are presented. In response, the Examiner simply states that "For the above-reasons, the rejections of all these listed claimed features is maintained as submitted in the final Office Action". However, various features identified in the Appeal Brief have not been addressed in the Examiner's Answer. For example, claim 44 requires a storage device and processor which have not been previously discussed in the Examiner's Answer. Nor have various of the supporting arguments been addressed previously in the Examiner's Answer.

Although on pages 20-21, the Examiner asserts that no improper hindsight was used in rejecting the clams, the record evidences otherwise. As discussed above, the Examiner has failed to establish knowledge which would suggest the present invention as recited in the claims of the subject application. It is again respectfully submitted that the proposed combinations of the applied references themselves are unmotivated and fail to provide any teaching or suggestion of the features or advantages of the presently

claimed invention. Indeed, the applied prior art teaches against that which is claimed in the present application, and attempts to solve similar problems in entirely different ways. It is further respectfully submitted that modification of the applied prior art as proposed by the Examiner would violate principles of operation of the prior art.

Thus, the rejection of the pending claims under 35 USC §103(a) is in error, and reversal is clearly in order and is courteously solicited.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 1158.41324CC7) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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